

REMARKS

Reconsideration of the present application is respectfully requested. Claims 1, 3, 4, 6, 8 and 9 are pending here, and are rejected under 35 U.S.C. §103(a) as unpatentable over Seo, et al. in view of Bechevet, et al. (claims 1, 4, and 9); Seo, et al. in view of Rie, et al. (claims 1, 3, 4, 6, and 8-9); Seo et al. in view of Rijpers, et al. (claims 1, 3, 4, 6, and 8-9); Seo et al., in view of Ogawa, et al. (claims 4, and 9). It is submitted that based upon the action taken herein, all remaining claims under consideration are in condition of allowance.

Seo, et al. (JP 01-180387) and the other cited references do not disclose the thickness of the recording film, previously recited in dependent claims 2, 5, 7 and 10 (now canceled), and now recited in independent claims 1, 4, 6 and 9. It is observed that Seo, et al. only discloses an example regarding the recording film having the thickness of 100 nm. This clearly does not teach, suggest or motivate the skilled person to employ the applicant's claimed range. For this first reason, it is submitted that the claims are patentable over the combined teachings of the references.

Further, the present invention employs a recording film having a main composition represented by $(\text{GeTe})_x\text{Sb}_{2-y}\text{In}_y\text{Te}_3$, and its composition ratio is within the ranges of $0.04 \leq y < 2$ and $4 \leq x \leq 8$. Specifically, in the recording film of the claimed invention, a portion of Sb in Sb_2Te_3 is replaced with In. In contrast, Seo, et al. only discloses the recording film having a chemical composition of GeTe and InSb. Further, the present invention achieves a high C/N value, a cross-erasing reduction, and a high erasing rate. In contrast, Seo only mentions the C/N value, and does not indicate that it attains the cross-erasing reduction and the high erasing rate. Nothing in Seo teaches, suggests or motivates the person of skill in the

art to make the changes to the recording film necessary to arrive at the recording film of the claimed invention.

Moreover, the secondary references cited in combination with Seo, et al. do not teach suggest, or motivate the person of skill in the art to make the modifications in the recording film composition of Seo in the way(s) needed to arrive at the presently claimed invention. Bechevet teaches (GeTe) (SbTe) (InTe), in which, as best understood, some of which elements can drop out of the composition entirely. Furthermore, with regard to recording medium thickness, claimed herein to be equal to or greater than 6 nm, and equal to or smaller than 13 nm, Bechevet clearly teaches outside this range. In any event, neither Bechevet nor Seo teach or suggest to a person of skill in the art that the recording film has a main composition represented by $(\text{GeTe})_x\text{Sb}_{2-y}\text{In}_y\text{Te}_3$, and its composition ratio is within ranges of $0.04 \leq y < 2$ and $4 \leq x \leq 8$. Seo teaches a recording film of (Te Ge) (In Sb); Bechevet teaches (GeTe) (SbTe) (InTe), in which, as indicated, some of which elements can drop out of the composition entirely.

Likewise, neither Ogawa, Rie nor Rijpers teach or suggest to a person of skill in the art that the recording film has a main composition represented by $(\text{GeTe})_x\text{Sb}_{2-y}\text{In}_y\text{Te}_3$, and its composition ratio is within ranges of $0.04 \leq y < 2$ and $4 \leq x \leq 8$. Ogawa teaches a composition of Ge-Te-Sb; Rijpers teaches a specific arrangement of GeIn SbTe. Rie teaches (Gn Sn) SBTe. Accordingly, the claimed invention cannot be arrived at from the disclosures of Seo and the secondary references. Selecting such chemical compositions of the cited references cannot attain the effects of the present invention.

The applicant observes that Seo and Bechevet are non-English language references. The examiner is reminded that pursuant to M.P.E.P. §706.02, translations must be provided to the applicant. This section provides that:

“If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection. The rationale for this is several-fold. It is not uncommon for a full text document to reveal that the document fully anticipates an invention that the abstract renders obvious at best. The converse may also be true, that the full text document will include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103, when the abstract alone appears to support the rejection. An abstract can have a different effective publication date than the full text document. Because all patentability determinations are fact dependent, obtaining and considering full text documents at the earliest practicable time in the examination process will yield the fullest available set of facts upon which to determine patentability, thereby improving quality and reducing pendency.”

Thus, the applicant hereby requests translations of the Seo and Bechevet references, as it is his right to have the translation of same made of record in this proceeding.

Wherefore, based upon the foregoing, it is submitted that the present application is in condition of allowance, and a relatively early reply would be greatly appreciated.

Respectfully submitted,



Richard J. Danyko
Registration No. 33,672

SCULLY, SCOTT, MURPHY & PRESSER, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343